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09/658,977	09/11/2000	Steven J. Sculler	M&R 3.0-033	5802

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EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/658,977

Applicant(s)

SCULLER ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant amendment received on 6-16-03 amended the specification and claims 1, 2, 4, 9 – 46 as well as submitted acceptable drawings.

Currently, claims 1- 46 are pending.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In Claims 1 – 35 and 41 - 46, the claimed invention is directed to non-statutory subject matter. The claim is directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. See *In re Johnston*, 183 USPQ 172 (CCPA 1974) and *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452. For example in claim 1, the invention in the body of the claim does not recite the use of nor incorporate any technology in carrying out the recited method steps and therefore is not statutory. If the invention in the body of the claim is not tied to the technological arts, environment or machine, the claim is not statutory. See *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) [Unpublished] and note MPEP 2106 IV 2(b). While *Bowman* is not precedential, it has been cited for its analysis.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1 – 3, 5 – 20, 35 – 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schkedy (US 6,260,024 B1) in view of Sharp (US 6,263,317 B1).**

Regarding claim 1 and related claims 35, 36 and 39, the combination of Schkedy and Sharp teach a computer-implemented method of retrieving product distribution information comprising: (a) where Schkedy teaches storing a plurality of first relationships where each relationship identifies a buyer, a seller and a product to be provided from said seller to said buyer (see at least Abstract, Col 1, lines 8 – 12 and Figure 1), (b) said retrieving a first relationship, wherein the first relationship identifies a first entity as said buyer, a second entity as said seller, and a first product as said product (see at least Col 10, lines 1 – 28 and Figure 2). Additionally and regarding claim 3, Shkedy teaches a method wherein said product is a stamp. Please note that Schkedy does identify products. However, Schkedy does not specifically connote one of the products to be a stamp – even though the reference does address ordering office products such as pens. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have added stamps to the products of Shkedy in order to increase customer satisfaction with the office supplies selection. Regarding

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claim 5, Shkedy teaches a method wherein said product is a service or a product and a service (Col 10, lines 29 – 31). Additionally and regarding claim 6, Shkedy teaches a method wherein said steps of storing relationship information further comprises storing the compensation which seller agrees to accept for said product from said buyer (Col 10, lines 44 – 47) and (7) wherein said compensation is the price of the product – as well as wherein said compensation is a commission (Col 8, line 8). Regarding claim 9, Schkedy teaches a method wherein said first entity is a class of entities (Col 3, lines 40 – 41) and (10) wherein said class is the general public (Col 5, lines 32 – 35) – as well as (11) wherein said step of retrieving said first relationship information comprises displaying to said first entity at least two products associated with those relationships identifying said first entity as said buyer, and determining said first relationship information based upon the product selected by an entity of said class (Col 13, lines 44 – 46). Regarding claim 12, Shkedy teaches a method further comprising the step of storing a description of said product (Col 10, lines 26 – 32 and Figure 2) and (13 and related claim 42) wherein said description comprises an image, a textual description, or an image and a textual description (Col 10, lines 26 – 30). Furthermore and regarding claim 37, Shkedy teaches a system wherein database is stored at a central location (Col 9, lines 20 - 23 and Figures 1 and 4) and (38) wherein said database is stored in a single server (Col 9, lines 20 – 23 and Figures 1 and 4).

However, Schkedy does not specifically disclose and teach (c) determining whether a second relationship identifies the seller in said first relationship as a buyer in said

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second relationship and whether the product in the second relationship relates to said product in the first relationship, (d) retrieving said second relationship dependant upon the result of the step of determining.

On the other hand, Sharp teaches (c) determining whether a second relationship identifies the seller in said first relationship as a buyer in said second relationship and whether the product in the second relationship relates to said product in the first relationship (see at least Abstract, Col 1, lines 36 – 62 and Figure 1), (d) retrieving said second relationship dependant upon the result of the step of determining (see at least Abstract and Col 3, lines 22 – 29). Moreover:

regarding claim 2, Sharp teaches a method further comprising the step of storing a third relationship identifying said the seller in the second relationship as a buyer in the third relationship, and where the product in the third relationship is related to the product in the second relationship (Abstract and Col 3, lines 22- 29).

regarding claim 14, Sharp teaches a method further comprising the steps of: (a) said first entity requesting the product from said second entity and storing said request, (b) storing a request for said first product by said second entity to said third entity based on the second relationship information (Abstract and Figures 1, 3 and 4) and (15) further comprising notifying said third entity of said request (Abstract and Figures 1, 3 and 4) – as well as (16) wherein said requests includes the quantity of said produce. Please note

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that Sharp does not specifically reference quantity. However, it is old and well known that an order would include quantity. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include quantity.

regarding claim 17, Sharp teaches wherein said destinations of requests include the shipping destination or destinations of said product (Figure 3).

regarding claim 18, Sharp teaches a method wherein said step of retrieving said second relationship information comprises searching for relationships wherein relationship identifies the seller of said first relationship and the product of the relationship identifies the product of said first relationship (Abstract, Col 5, lines 26 – 43 and Figure 4).

regarding claim 19, Sharp teaches a method further comprising the steps of storing additional relationships associated with said product; repeating said step of retrieving said second relationship by recursively assuming that some of the values of said first relationship are equal to the values of said second relationship (Abstract and Figure 4) and (20) wherein said step of repeating terminates when there is no relationship identifying the seller of said second relationship as a buyer of the same product in another relationship (Figure 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Shkedy with the method and system of

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Sharp to have enabled teach a computer-implemented method of retrieving product distribution information comprising: (a) where Schkedy teaches storing a plurality of first relationships where each relationship identifies a buyer, a seller and a product to be provided from said seller to said buyer, (b) said retrieving a first relationship, wherein the first relationship identifies a first entity as said buyer, a second entity as said seller, and a first product as said product, (c) determining whether a second relationship identifies the seller in said first relationship as a buyer in said second relationship and whether the product in the second relationship relates to said product in the first relationship, (d) retrieving said second relationship dependant upon the result of the step of determining – in order to ensure ordering capability with partners/suppliers to more closely integrate and reduce the order timeframe and thus ensure rapid response to customer orders. With this rapid response to customer orders, through this closer integration of partners, will delight the customers when they receive the product rapidly and thereby increase the probability of another order.

**Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Shkedy and Sharp as applied to claim 1 above, and further in view of Peterson (US 6,324,522 B2).**

The combination of Shkedy and Sharp substantially disclose and teach the applicant's invention.



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However, the combination does not specifically disclose and teach a method wherein the product in the first relationship is a first product, the product in the second relationship is a second product, and the first and second products are related if the said first product is a part or all of a second product.

On the other hand and regarding claim 4, Peterson teaches a method wherein the product in the first relationship is a first product, the product in the second relationship is a second product, and the first and second products are related if the said first product is a part or all of a second product (see at least Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Shkedy and Sharp with the method of Peterson to have enabled a method wherein the product in the first relationship is a first product, the product in the second relationship is a second product, and the first and second products are related if the said first product is a part or all of a second product – in order to ensure that products can be obtained quickly. In this manner, the customers will receive products rapidly, which will increase customer satisfaction. With the increased customer satisfaction, the probability that the customer will return for additional ordering will be increased.

**Claims 21 – 25, 27, 30 - 34 and 41 - 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over “iPrint, Inc. Technology Selected to Power Leading Office Services Franchise”; Business Wire; New York; Feb. 8, 1999, Business Editors and “iPrint.com to Offer Free Picture Mug to Intel WebOutfitter Service Members”; Business Wire; New York; Aug. 17, 1999; Business Editors/Technology Writers (hereafter referred to collectively as “iPrint”) in view of Webber Jr. (US 6,167,378).**

Regarding claim 21 and related claims 39, 41 and 43, the combination of iPrint and Webber teach a computer-implemented method and system of providing information about a product - including where iPrint teaches about online ordering including product that include typesetting and comprising: (a) storing data representing a product available from a mid-level entity to a class of customers, said product including typesetting (Page 1, Para 1 – 5); (c) receiving a customer request from a customer of said class of customers for said product, said customer request including typesetting information describing said typesetting (Page 1); (d) storing said customer request (Page 1). Regarding claim 22, iPrint teaches a method wherein said class of customers comprises a single entity (Page 1) and (24) wherein said typesetting information comprises an image (Page 3). In addition and regarding claim 25, iPrint teaches a method further comprising the steps of receiving a plurality of requests from a plurality of customers of said class of customers, and wherein the image associated with one customer request is different from the image associated with another customer request

(Pages 3 and 4). Regarding claim 32, iPrint teaches a method wherein said product is a stamp and said typesetting relates to the impression on said stamp (Page 2) and (33) wherein said requests identify said typesetting information by reference to information stored in a database (Page 2) as well as (34) wherein said step of receiving said customer request comprises receiving said customer request over a global telecommunications network (Pages 1 and 2). Furthermore and regarding claim 45, iPrint teaches a method wherein said product comprises a stamp having an impression representing said image (Page 2) and (46) wherein said product comprises a printed item or sign containing said image (Page 3).

However, iPrint does not specifically teach (b) storing data representing an agreement by a top-level member to provide said product to said mid-level member (e) retrieving said agreement based on the identity of said product and the identity of said mid-level member associated with said customer request, wherein the agreement identifies the mid-level member as the recipient of the product provided by the top-level member; (f) generating a second request that said top-level member provide said product to said mid-level first member, said second request identifying said typesetting information; (g) transmitting said second request to said top-level member.

On the other hand, Webber teaches a method and system of (b) storing data representing an agreement by a top-level member to provide said product to said mid-level member (see at least Abstract, Col 1, lines 18 - 28 and Figure 4); (e) retrieving

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said agreement based on the identity of said product and the identity of said mid-level member associated with said customer request, wherein the agreement identifies the mid-level member as the recipient of the product provided by the top-level member (see at least Figure 4); (f) generating a second request that said top-level member provide said product to said mid-level first member, said second request identifying said typesetting information (see at least Col 1, lines 20 – 21 and Figure 4) ; (g) transmitting said second request to said top-level member (see at least Col 1, lines 20 – 21 and Figure 4). Moreover:

regarding claim 23, Webber teaches a method further comprising storing data representing an agreement by a third member to provide said product to said top-level member; retrieving said agreement by said third member based on the identity of said product and the identity of said top level member (Figure 4).

regarding claim 27, the recitations that “retrieving said image”, such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “retrieving” already disclosed by Webber.

regarding claim 31, Webber teaches a method further comprising the step of manufacturing said product (Figure 4).

regarding claim 40, Webber teaches a system wherein said data further comprises another agreement by another entity to provide said product to said top entity (Figure 4).

regarding claim 44, Webber teaches a method further comprising the step of said members storing said agreements by sending information relating to such agreement to said database (Col 5, line 36).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Shkedy with the method of Sharp to have enabled a computer-implemented method and system of providing information about a product online ordering including product that include typesetting and comprising: (a) storing data representing a product available from a mid-level entity to a class of customers, said product including typesetting (Page 1, Para 1 – 5); (b) storing data representing an agreement by a top-level member to provide said product to said mid-level member; (c) receiving a customer request from a customer of said class of customers for said product, said customer request including typesetting information describing said typesetting (Page 1); (d) storing said customer request; (e) retrieving said agreement based on the identity of said product and the identity of said mid-level member associated with said customer request, wherein the agreement identifies the mid-level member as the recipient of the product provided by the top-level member; (f) generating a second request that said top-level member provide said product to said mid-level first member, said second request identifying said typesetting information; (g) transmitting

said second request to said top-level member – in order to ensure ordering capability with partners/suppliers to more closely integrate and reduce the supply chain order timeframe and thus ensure rapid response to customer orders. With this rapid response to customer orders, through this closer integration of partners, will delight the customers when they receive the product rapidly and thereby increase the probability of another order.

**Claims 26, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of iPrint and Webber as applied to claims 25 and 27 and further in view of Hess et al (US Patent 6,058,417).**

The combination of iPrint and Webber substantially disclose and teach the applicant's invention.

However, the combination does not specifically teach a method wherein said step of storing said customer requests from said customers comprises storing said different images in the same file format or comprising the step of converting said image from said file format to a different file format before said step of said top-level member retrieving said image. Nor does the combination specifically disclose and teach a method wherein said step of storing said customer requests from said customers comprises storing said different images in different file formats or wherein said different file formats correspond with file formats used by said members.

On the other hand and regarding claim regarding claim 26, Hess teaches a method wherein said step of storing said customer requests from said customers comprises storing said different images in the same file format (Col 3, lines 10 – 30).

Regarding claim 28, Hess teaches a method further comprising the step of converting said image from said file format to a different file format before said step of said top-level member retrieving said image (Figures 7 – 10).

Regarding claim 29, Hess teaches a method wherein said step of storing said customer requests from said customers comprises storing said different images in different file formats (Col 3, lines 20 – 25 and Figure 10) and (30) wherein said different file formats correspond with file formats used by said members (Col 3, lines 20 – 25 and Figure 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of iPrint and Webber with the method of Hess to have enabled a method wherein said step of storing said customer requests from said customers comprises storing said different images in the same file format or comprising the step of converting said image from said file format to a different file format before said step of said top-level member retrieving said image; and wherein said step of storing said customer requests from said customers comprises storing said different images in different file formats as well as wherein said different file formats correspond

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with file formats used by said members – in order to ensure that different file formats do not slow up the process of orders or increase cost of participants in buying new equipment. In this manner, the entire chain will be much more responsive and thereby reduce delivery times, which will enhance customer satisfaction. This increased customers satisfaction will increase the probability that end customers will recommend the service to others, which will increase the revenue for all members in this supply chain.

### ***Response to Arguments***

The applicant did not submit any arguments with the amendment.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230.

The examiner can normally be reached on M-F 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 703.308.3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

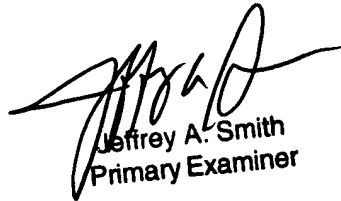
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.



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RER



Jeffrey A. Smith  
Primary Examiner